

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAKOBUS MIDDELJANS

Appeal 2007-1518
Application 10/068,909
Technology Center 2100

Decided: November 30, 2007

Before JAMES D. THOMAS, KENNETH W. HAIRSTON,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 14. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. An arrangement (100) for distributing content (200), comprising an aggregator (101) arranged for bundling the content (200) according to a

segment profile (209) and distributing the content (200) to receiving device (120),

the receiving device (120) comprising user profile maintenance means (210) for maintaining a user profile (211), and profile transmitting means (212) for transmitting the user profile (211) to a profiling center (220),

the profiling center (220) being arranged for aggregating user profiles (211) received from plural receiving devices (120) into an aggregated profile (221), and for making the aggregated profile (221) available to the aggregator (101) for use as the segment profile (209).

The following references are relied on by the Examiner:

Van Wie	US 6,240,185 B1	May 29, 2001
Davis	US 6,611,607 B1	Aug. 26, 2003
		(Filing date March 15, 2000)
Liu	US 6,839,680 B1	Jan. 4, 2005
		(Filing date September 30, 1999)

Claims 1, 3, 6, 7, 8, 11, 13, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Liu in a first stated rejection. In a second stated rejection, Liu is utilized with Davis within 35 U.S.C. § 103 as to claims 2 and 12. Correspondingly, in a third stated rejection, Liu is utilized with Van Wie as to claims 4, 5, 9, and 10 in a second rejection under 35 U.S.C. § 103.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the Brief and Reply Brief for Appellant's positions and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as amplified here, we sustain each of the three stated rejections of the claims on appeal after having given due consideration to Appellant's arguments in the Brief and Reply Brief. The Examiner has correlated the stated features of each of the rejected claims to the corresponding features disclosed in the respective references relied upon, and the Examiner has directly addressed each of the respective arguments presented in the principal Brief on appeal, where the Examiner has particularly isolated the arguments in the responsive arguments portion beginning at the bottom of page 9 through page 12 and directly addressed them in a corresponding manner beginning at page 13 to the end of the Answer.

At the outset, although we recognize that there is no direct issue presented before us with respect to the claims on appeal, from our own initial perspective we note here that the claims on appeal are subject to rejections under the second paragraph of 35 U.S.C. § 112. The language utilized in the claims including "arranged for," "for," "for use as/in," and "to" directly relate to future acts that may never occur. There are no present

tense acts set forth, for example, in independent claim 1 on appeal.

Therefore, the scope and the metes and bounds of the claims are not certain with a reasonable degree of particularity to permit the artisan to understand the potential for, and therefore the need to avoid, potential infringement.

Nevertheless, for purposes of rendering a decision on the three art rejections before us, we consider the claims as if they recite positive limitations in a present tense setting regarding the exemplary language noted in the previous paragraph. According to the anticipation rejection, as well as the two stated rejections under 35 U.S.C. § 103, the Examiner has reasonably correlated the respective features recited to the teachings in a corresponding manner to those in the references relied upon. Although the references do not necessarily disclose the claimed features in the same words or utilize the same terms, the references do teach the concepts recited in the claims. As noted by the Examiner at page 17 of the Answer, for example, the disclosures in the respective references are equivalent to Appellant's claimed invention.

Much has been said in the Brief and Reply Brief with respect to the claimed feature in representative independent claim 1 of "according to a segment profile" which has a corresponding recitation at the end of this

claim “for use as the segment profile.” With respect to apparatus claims 1 through 7, any use of the device with respect to the segment profile is considered a limitation that is not given patentable weight. A different intended use of the same structure as in the prior art does not prohibit a statutory anticipation rejection, for example. Indeed, it has been stated by our reviewing court that “the absence of a disclosure relating to function does not defeat the Board’s finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable (case citations omitted).” In re Schrieber, 128 F.3d 1473, 1477 (Fed. Cir. 1997). The court concludes at 128 F.3d 1477, that “Schrieber’s contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in anyway in connection with popcorn (emphasis added).” Such reasoning obviously applies to rejections under 35 U.S.C. § 103. Schrieber confirms the guidance provided in Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus for a prior art apparatus satisfying the claimed structural limitations. Note also Ex parte

Wikdahl, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Int. 1989) and In re Casey, 370 F.2d 576, 580 (CCPA 1967).

We do not agree with the assertions in the Brief and Reply Brief that the rejection itself does not address the subject matter of the segment profile with respect to the Liu reference. We agree with the Examiner's basic views that the labelling, in essence, of a segment profile as distinguished from the other types of profiles generated in Liu is a non patentable distinction.

Independently, however, we observe that Liu teaches, for example in figures 13 through 15, the concepts of categories of content with respect to what a client company categorizes for profiling purposes, such as music, sports, news, etc., which correspond to the claimed segment profile.

Correspondingly, the arguments at pages 2 through 4 of the Reply Brief do not deny the existence in Liu of corresponding teachings, but merely urge, in essence, that Liu does not teach a local user profile being influenced by user profiles that are not local to a hub. This argument is unpersuasive since there is no corresponding limitation recited in independent claim 1 on appeal to therefore distinguish over the teachings in this reference.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996). “[T]he Examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.3d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Examiner’s positions with respect to the two stated rejections under 35 U.S.C. § 103 appear to be consistent with the requirements according to this case law from the United States Supreme Court and the Federal Circuit too.

As to the second stated rejection, there appears to be no real dispute that Liu does teach the existence of metadata as identifiers for content information but does not teach directly the use of watermarking. Davis, on the other hand, as well expressed by the Examiner in a succinct manner, correctly observes that Davis not only teaches the use of such metadata but also, in the context of data content security purposes, additionally utilizes watermarking as a further enhancement and protection as well to control

access to the content of various types of information. Davis, therefore, would have been an obvious enhancement to the teachings already present with respect to metadata in Liu.

Correspondingly, the Van Wie reference also utilizes watermarking because of its title relating to steganography and it does so in a digital rights management environment, again to improve overall content information security. Additionally, the teachings outlined by the Examiner with respect to the claims in the third stated rejection relating to a digital rights clearinghouse and a financial clearinghouse respectively are plainly taught in this reference. Again, within the above noted case law, it would have been obvious for the artisan to have improved upon Liu's teachings by the further use of the teachings in Van Wie.

The above analysis sets forth our basic agreement with the Examiner's reliance upon the identified prior art for the three stated rejections. Independently of the Examiner's stated rejections, we additionally note in passing that it appears to us that the subject matter presented in all claims on appeal relates to features that may differ from the prior art solely on the basis of "non-functional descriptive material," which is generally not given patentable weight when determining patentability of an invention over the prior art. *In re Gulack*, 703, F.2d 1381, 1385 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981). However, the Examiner need not give patentable weight to

descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

We conclude that when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, we conclude that such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. In the instant case on appeal, with respect to the identification of the user profiles and even the argued feature of segment profiles recited in the claims on appeal, these alleged patentable distinctions relate to non-functional descriptive material which does not provide a patentable distinction to the data or to the process itself of the claimed method or the broadly recited “arrangement” of independent claim 1 on appeal. In other words, we find that the meaning relating to the characterization of what a profile is or is not, or a label attached to data that may be characterized as a profile, cannot be used to distinguish the claimed invention from the prior art approaches in these references relied upon by the Examiner. Therefore, we conclude that the invention of claims 1 through 14 are not patentably distinguishable from the teachings of the applied prior art.

Finally, we also note in passing that the nature of the subject matter of the claims on appeal, particularly focusing upon the independent claims 1 and 8, for example, do not appear to be patentably distinguishable over the admitted prior art at Specification page 1, line 6 through page 2, line 13. It is plain to see that the segmentation profiles that are alleged to be a patentable distinction here were known in the art according to Appellant's own admissions. Features such as the degree of segmentation, the accuracy of the segmentation, or whether the segmentation is fine-grained or course-grained, are not recited in the claims on appeal. In accordance with the analysis provided by us in the previous paragraph, even if the claims did recite these features, they would have appeared to be non-patentable anyway.

In view of the foregoing, the decision of the Examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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